



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,884	03/09/2000	Cees A Van Der Voort	082671/0118	2555

7590 09/19/2002

Foley & Lardner
Washington Harbour
3000 K Street, N.W.
Suite 500
Washington, DC 20007-5109

EXAMINER

HOAS, WENDY C

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 09/19/2002

C

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/521,884 Examiner Wendy Couchoud Baker	Applicant(s) Van Der Voort	Art Unit 1661
		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Sep 28, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) Other: *Rule 1.105 Requirement for information*

Art Unit: 1661

DETAILED ACTION

Status of Application

The request filed on September 28, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/521, 884 is acceptable and a CPA has been established. An action on the CPA follows.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It states that the instant plant was “ discovered in a cultivated area **and/or** asexually reproduced”. The declaration must state that the applicant has asexually reproduced the instant plant, such as, for example, “I state that I have invented, or discovered in a cultivated area, **and** asexually reproduced the new and distinct plant.”. Appropriate correction is required. See 37 CFR 1.162, MPEP 1604.

35 USC § 102

The claimed *Lilium* variety ‘Corso’ is described in Breeder’s Right grant number 019237 granted by the Netherlands on May 10, 2000. The application for this grant, made September 9,

Art Unit: 1661

1998 was numbered LEL 1580 and was published on October 16, 1998, more than one year prior to the filing date of the instant application. The denomination of this plant was also published on November 16, 1998. The published grant application and denomination are “printed publications” under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. There may also be additional “printed publications” associated with this application and/or grant that are not listed on the reference provided from UPOV. For example, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the grant are obtainable through the Netherlands Board of Plant Breeders’ Rights. Notice of Plant Breeder’s Right grants is also published in the *Nederlandse Staatscourant*. Plant varieties are also entered in the Netherlands Register of Varieties, which is public. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art. It also appears that plant Breeder’s Rights were applied for by applicant in Belgium, Chile, Germany, Poland and South Africa (see attached references). These countries may also publish applications and grants, creating similar “printed publications” under 35 U.S.C. 102 that disclose the instant plant.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one

Art Unit: 1661

skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) (“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publications cited above disclose the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the published application, proposed denomination or granted PBR certificate, combined with knowledge in the prior art, would enable one or ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the internet and the Office’s collection of retail catalogs has not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the Office’s collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

Art Unit: 1661

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

Art Unit: 1661

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. Page 1, line 9, it is suggested that applicant change the word "erected" to --erect--, or similar.

B. Page 3, line 4, applicant must provide the age of the plant described in the Detailed Botanical Description, as well as the botanical/horticultural conditions such was grown under (for example, temperature, day length, light levels, fertilizer and watering rates, etc.). Further information is needed.

C. Page 3, line 17, applicant sets forth that the plant is "A single stem carrying numerous, alternately arranged pedicels". It would appear from the photographic illustration provided with the application that the plant displays numerous, alternately arranged leaves. Correction and/or clarification is required.

Art Unit: 1661

D. Page 3, line 20, applicant sets forth the growth habit of the instant plant as "Vigorous". Applicant should provide additional information as to the vigor of the instant plant, such as growth over a particular period of time and/or time to maturity, as the height of a mature plant is set forth in the specification at present.

E. Page 3, lines 21/22, applicant should provide a color chart designation for the "anthocyanin pigmentation present in spots and stripes" on the stem of the instant plant.

F. Page 4, line 1, it is suggested that applicant add the words --per plant--, or --per stem--, whichever is accurate, after the recitation "45", in order to clarify the information set forth.

G. Applicant should import into the specification information regarding the specific botanical features of the instant plant such as leaf apex shape, leaf base shape, bulb shape, a botanical descriptor for bud shape (the recitation "Tapering like a lancet" is insufficient in this regard), bud diameter, tepal length, width and shape for the inner and outer tepals, pedicel diameter, and information regarding the seeds of the instant plant, such as whether the plant sets seed, amount of seed set and seed color, size, shape and fertility.

H. Applicant should provide color designations and/or supplement the general color descriptions currently set forth with color designations from the employed color chart, for such

Art Unit: 1661

characteristic botanical features as foliage (upper and lower surface), stem, color chart color for the "gray shading" on the flower bud, bulb color, flower mid-vein color, color of the "dark purple spots and markings" on the blooms of the instant plant, pedicels, anther, filament, pollen and pistil.

I. Applicant should provide the time it takes for the buds to unfurl and/or the typical and observed environmental conditions needed for bloom, if available.

J. Page 4, line 20, applicant should clarify what the flower size set forth is intended to indicate, (for example, diameter, depth, etc.) and provide flower depth and/or diameter, if not indicated in the specification at present.

K. In addition to providing the typical and observed height of the instant plant, applicant should provide the spread (width or diameter) of the instant plant at a given age and location of culture.

L. If available, additional information relative to plant disease/pest resistance/susceptibility, should be set forth in the specification. Information provided should specify whether the resistant/susceptible character is a general characteristic of the species, or if the instant plant is resistant/susceptible to diseases/pests as compared to the species as a whole. Page 5, line 11,

Art Unit: 1661

applicant sets forth that the bloom of the instant plant displays a “Medium” resistance to disease, but fails to indicate which disease(s) the blooms show resistance to, and fails to provide information regarding the resistance of the plant as a whole.

M. Applicant sets forth that the instant plant is fragrant. Applicant should describe the fragrance of the instant plant, if possible. Typical descriptions might be: Strong and sweet, Light, lemony, etc.

N. Applicant import into the specification information regarding the lastingness of the individual bloom for the flowers of the instant plant.

O. If available, applicant should set forth information regarding the cold hardiness of the instant plant.

P. Page 5, applicant sets forth the length of the stamens and anthers as “Short to medium, depending on cultivation conditions”, but fails to specify whether it is the anthers or the filaments that are “short to medium”, and fails to specify what the cultivation conditions that would cause the length to vary are. Further information is needed.

Art Unit: 1661

Q. The designation(s) for flower bud and flower color set forth in the specification do not reasonably correspond with the color(s) illustrated. Specifically, the illustrated flower buds appear to be a light green color before they are the 66D pink color recited. Additional information regarding the light green color of less mature flower buds is required. In addition, the flowers appear to have bright orange and bright yellow shading along the middle of the petals in addition to the green midvein mentioned in the specification and the RHS 66C petal color set forth. Further information is needed.

If the source of the noted discrepancies is due to photographic error, it may be necessary for applicant to file a substitute photographic illustration (properly mounted and in duplicate) which more reasonably corresponds to the color designations set forth in the specification or else attempt to somehow account for same. The colorations illustrated and the color designations in the specification must reasonably correspond to each other and must faithfully set forth/depict the true and characteristic features of the plant.

The above listing may not be complete. Applicant should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Art Unit: 1661

Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above, and under 35 U.S.C. 112 first paragraph for the reasons advanced in the objection to the oath/declaration.

References Cited

The references cited on the attached PTO-892 are made of record to show the state of the art, and are believed to be the same cultivar as the claimed plant.

Drawing Changes

Applicants are advised of the changes to 37 CFR 1.84 which took effect November 29, 2000. In particular, 37 CFR 1.84(e) now states, in part:

Photographs must be developed on paper meeting the sheet size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section.

The USPTO no longer accepts photographs mounted on bristol board, paper or other material.

Further information on the new rules is available on the USPTO web site at www.uspto.gov.

Drawings should be mailed to PO BOX 2327 Arlington, Virginia 22202 or sent to the Examiner via UPS, Federal Express or may be hand delivered.

Art Unit: 1661

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (703) 308-8898. The Examiner's current work schedule is available at the above telephone number.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3041 or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

W. C. Haas

Art Unit: 1661

ATTACHMENT

REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Corso', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide copies of the published application, published proposed denomination and published Breeder's Right grant. The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. Since the assignee of the instant application is listed by UPOV as applicant, breeder and title holder of the granted Breeder's Right, it is reasonable to expect that Applicant or the assignee can readily obtain the requested documents and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.



BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600